



UNITED STATES DEPARTMENT OF COMMERCE  
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**Mailed**

**AUG 16 1999**

Paper No. 48

**Director's Office  
Group 2700**

*In re* Application of Forest

Appl. No.: 08/506,032

Filed: July 24, 1995

For: DATA ENTRY METHOD AND APPARATUS

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: **DECISION ON PETITION**  
: **FILED UNDER**  
: **37 CFR 1.181**  
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This is a decision on the petition received July 6, 1999. The petition was filed under 37 CFR 1.181, and requested that:

- 1) the finality of the Office action, mailed November 12, 1998, be withdrawn,
- 2) the video tape, filed April 12, 1999, be entered,
- 3) the amendment after Final, filed on April 14, 1999, be entered, and
- 4) petitioner be compensated for losses he sustained due to PTO nonfeasance.

### **BACKGROUND**

The prosecution has been long and protracted. Not every Office action or response by applicant is listed below:

March 22, 1996	-	Examiner Weldon issued election of species requirement.
May 6, 1996	-	Examiner Weldon issued first Office action on the merits rejecting claims.
February 24, 1997	-	Application reassigned to Examiner Liang, who issued another Office action rejecting claims.
May 27, 1998	-	Examiner Liang issued another non-final Office action, rejecting claims 1, 19-58, 61-80, 82-89, 94, 101-106, 108, 112-203.
November 12, 1998	-	Examiner Liang issued a Final Office action, rejecting claims 1, 19-41, 43-58, 61-80, 82-89, 94, 101-106, 108, 112-205.
April 14, 1999	-	Applicant filed amendment after Final, and a Notice of Appeal.
May 6, 1999	-	Examiner Liang issued an advisory action maintaining Final rejection and denying entry of applicant's amendment filed April 14, 1999.

*Decision on Petition***DECISION**

This prosecution of this application does not exhibit the normal practice before the PTO. It is not normal for the applicant to be forced to respond to so many non-final Office actions, nor is it normal for the examiner to be forced address the unreasonable number of claims that were filed in this application.

This decision will address petitioner's arguments in sequence beginning on page 4 of the petition. Petitioner argues that the Final Rejection (hereinafter Final) is premature because the examiner stated a new ground of rejection for claim 19 for the first time in the Final. In the May 27, 1998 non-final Office action, the examiner rejected claim 19 as obvious over Ito et al (Ito) in view of numerous other references. The Final maintained the same combination of references in rejecting claim 19. Even if, as alleged by petitioner, the examiner modified her position in applying Ito to reject claim 19, this would not be sufficient grounds to remove the Finality. In the extreme situation caused by there being almost 200 pending claims, it is entirely reasonable for an examiner to expound on the teaching of Ito, or any other reference, in an Office action. Adding a new argument or referring to a previously unstated teaching of a reference is not sufficient grounds to withdrawal Finality.

Petitioner refers to page 11, lines 15-17, of the Final as evidence of an improper new ground of rejection with respect to claim 32, which was not amended. This portion of the Final is responding to arguments submitted in the September 29, 1998 response to the previous non-final Office action. The examiner is entitled to respond to arguments submitted by applicant. When done, this is not a new grounds of rejection.

Petitioner argues that the examiner has not addressed every single limitation in each of the claims. As noted above, this in an extreme application with almost 200 claims. The record demonstrates that the examiner has attempted to address the claims and references in a full and complete manner. In view of the already long and protracted prosecution, it would not be in the interest of the patent system to delay the prosecution even more by issuing another action to address limitations that might have been overlooked, or at least, not specifically addressed. The propriety of the examiner's proposed art rejections and grounds for obviousness can be argued before the Board of Patent Appeals and Interferences (Board).

The arguments advanced on pages 8 and 9 by petitioner appear directed to arguments in support petitioner's conclusion of the non-obviousness of the reference combinations as applied to the claim limitations. This is an appealable rather than a petitionable issue, and should be decided by the Board.

Petitioner, on page 11, items 1 and 2, refers his expectation to resolve all of the outstanding issues at a July 1997 interview. In view of the limited time available at an interview, it is unreasonable to expect that all of the outstanding issues affecting almost 200 claims can ever be resolved within

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the 30 minutes, or even one hour, that is available for an interview. That interview took place over two years ago. It is untimely to now bring to the Director's attention that the interview could have been handled better.

Petitioner, on page 11, item 3, refers to an IDS being mishandled, but this issue is not germane to the relief requested in this petition. Item 4, on page 11, misrepresents the facts. Granted the Ito reference was not applied against the claims in the February 27, 1997 action, but it was applied against the claims in both the Final action and the preceding action. The implication in petitioner's item 4 is that Ito was first applied in the Final, and that is clearly not true. Petitioner has to recognize that an examiner is permitted to reevaluate the references used in the preceding action when preparing the subsequent action. In this application, the examiner changed references after the February 27, 1997 action, and properly made the next action, mailed May 27, 1998, a non-final action. If this examiner was not permitted to reevaluate references before issuing a subsequent action, then she would be forced to allow claims which she, upon reconsideration, believed to be unpatentable. That is clearly an unacceptable outcome.

Petitioner has submitted arguments concerning due process, but the record does not demonstrate that the actions by the examiner in this regard have been unreasonable.

Page 12, part F, argues that the examiner has included her personal knowledge as a basis for the rejection. The petition itself recites no specifics to support this argument, but does reference other papers filed during the prosecution of this application. For example, pages 4 and 5 of the amendment after Final, filed April 14, 1999, refer to this topic. As noted above with petitioner's arguments on pages 8 and 9, it appears that petitioner, in page 11, part F, is attempting to establish the non-obviousness of the combination. This is not petitionable, rather it is appealable, before the Board, where appellant may challenge whether the examiner has met the legal requirements of 35 U.S.C. 103 for obviousness. But the petitioner cannot force, by way of a petition, the examiner to develop affidavits for every conclusion of obviousness. The issue raised by petitioner in this section are related to whether the examiner has made a prima facie case of obviousness, the propriety of which is appealable.

Petitioner refers to the advisory action, mailed on May 6, 1999, in page 12, part G. The completeness or propriety of this action do not appear to be in error, since the examiner is entitled to deny amendment entry if new issues are present. MPEP 714.13.

The video tape has been considered by the examiner as evidence submitted by applicant to establish patentability. Any evidence which has been considered by an examiner is "entered" into the application file. At this time, the examiner has not found the evidence on the video tape to be persuasive. To the extent petitioner wants the record to show that the video tape has been entered and considered, this has been done.

There were 28 pages of claim amendments in the amendment after Final, filed April 14, 1999. Petitioner argues that the amendment should be entered, but only addresses claims 39 and 46-48 as a basis for this entry. This petition decision need not determine whether the changes to the

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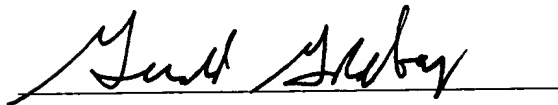
above mentioned claims would have been permissible, if separately filed, because no such amendment was ever filed. Petitioner has failed to demonstrate that the examiner's decision to deny entry of the totally of the after Final amendment was in error.

On page 14, petitioner argues that he should be awarded damages. Whether the PTO would be liable for damages is a decision for the Federal Court system, and cannot be resolved by petition.

In summary, other than the video tape being made of record, all other remedies requested by petitioner have been denied.

For the reasons given above, the petition is GRANTED, to the extent of entering the video tape, and otherwise DENIED.

The time remaining for filing an appeal brief continues to run from the notice of appeal date of April 14, 1999.

A handwritten signature in black ink, appearing to read "Gerald Goldberg", is written over a horizontal line.

Gerald Goldberg, Director  
Technology Center 2700  
Communications and Information Processing